

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Valerie M. Bennett, et al.

Serial No.: 10/733,985

Filed: December 11, 2003

For: Customized Subscription Builder

Art Unit: 3622

Examiner: Rodney M. Henry

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the Final Rejection in the Office Action mailed June 23, 2008 in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

/Marcia L. Doubet/

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GROUND OF REJECTION PRESENTED FOR REVIEW

The **Ground of Rejection** presented for review is a rejection of Claims 1 - 6 and 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,731,393 to Currans et al. (hereinafter, “Currans”), according to the Office Action mailed June 23, 2008 (hereinafter, “the Office Action”) and as further discussed in the Advisory Action mailed September 19, 2008 (hereinafter, “the Advisory Action”).

ARGUMENT

Applicants reserve the right to argue additional grounds with respect to the patentability of the claims if this Petition is denied.

As stated by the Court of Appeals for the Federal Circuit, “Anticipation under 35 U.S.C. §102 requires the disclosure in a single price of prior art of each and every limitation of a claimed invention.” *Apple Computer Inc. v. Articulate Sys. Inc.*, 57 U.S.P.Q.2d 1057, 1061 (Fed. Cir. 2000), emphasis added. In another case, the Court of Appeals stated that a finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). In yet another case, the Court of Appeals held that a finding of anticipation requires absolute identity for each and every element set forth in the claimed invention. See *Trintec Indus. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002).

The first element of independent Claim 1 recites “enabling a user to identify, from a

rendered view of content, a portion of the content which is of interest to the user”. Relative to this subject matter, the Office Action cites column 13, lines 55-57 of Currans. This passage states that “[n]ote that this document is a user’s personalized newspaper which contains information in which the user has indicated a specific interest in, as stored in the user profile in knowledge module 170.” There is no teaching or disclosure in this passage of a user, identifying from a rendered view of content, a portion of the content which is of interest to the user. No rendered view of content is taught or disclosed. *How the user in Currans indicates or identifies a specific interest in the information is not described.* Currans simply does not suggest, disclose or teach this subject matter.

The first element of Claim 1 further recites “wherein a renderer of the view of the content has not provided a subscription interface thereto”. Relative to this subject matter, the Office Action cites column 7, lines 23 - 27. This passage states that “[i]t should be noted that although depicted as an element of edit module 120, those skilled in the art will appreciate that content manager 518 may well be deployed as an [sic] separate and independent functional entity”. Edit module 120 as illustrated in Figure 13 includes a virtual editor 506 which includes the content manager 518. Relative to the content manager 518, Currans simply states in column 6, lines 47 - 53 “virtual editor 506 includes a content manager 518 ... [a]s the editor module 120 receives content from one or more content providers, content manager 518 is selectively invoked by controller[s] 502.” The content manager 518 includes an analysis agent 522, a contract administrator function 524 and a transaction agent 526. Further, in column 14, lines 12 - 31, Currans describes how the generator module receives content objects from content providers 50 and/or advertising providers 80 and invokes an instance of the content manager 518, which

classifies, wraps and store each of the received content objects. The content manager 518 invokes an instance of analysis/wrapper agent 522 to analyze and encapsulate the received content object in a trace wrapper. The content manager 518 then updates the content provider information data structure 620 associated with the provider of the content object to denote the wrapper identifier for the received content object.

In Currans' description and discussions of the content manager 518, there is absolutely no discussion that the content manager 518 is employed in connection with enabling a user to identify a portion of the content which is of interest to the user. Instead, the content manager 518 apparently manages the presentation of content to the user and does not assist in enabling a user to identify content of interest, either with or without a subscription interface. Accordingly, Applicants submit that Currans does not teach, suggest or disclose this subject matter from Claim 1.

Clearly, the anticipation rejection under 35 U.S.C. §102 over Currans fails to meet the requirements as put forth by the Court of Appeals for the Federal Circuit. As indicated above, Currans does not disclose each and every limitation of Claim 1. Applicants have demonstrated above that differences exist between Claim 1 and Currans. Thus, the rejection fails the requirement that a finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. Applicants have also demonstrated that the Office Action fails to demonstrate absolute identity for each and every element set forth in the claimed invention, as required for a finding of anticipation.

Further, Applicants have demonstrated above that Currans does not teach or suggest the claim limitations of Claim 1, Applicants submit that Claim 1 patentably distinguishes over Currans.

Dependent Claims 2 - 6 and 12 are deemed patentable by virtue of (*inter alia*) the patentability of the independent claim from which they depend.

In view of the above, Applicants respectfully request that the rejection in the Office Action be reversed by the appeal conference prior to the filing of an Appeal Brief.